

### **III. REMARKS**

Claims 23-33 are pending in this application. By this amendment, claims 1-4, 6-8, and 10-22 have been cancelled herein; and, claims 23-33 have been added. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed.

Furthermore, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is requested.

Claims 1-4, 6-8 and 10-22 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. Claims 1-4, 6-8 and 10-22 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-4, 6-8 and 10-22 are rejected under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter. Claims 1-4, 6-8 and 10-22 are rejected under 35 U.S.C 103(a) as being unpatentable over Machin et al. (US 6,877,034), hereinafter “Machin”, in view of Sanders (US 6,411,936), hereinafter “Sanders.”

Regarding the rejections under 35 U.S.C. 112, first and second paragraphs, Applicant respectfully contends that both the enablement and indefiniteness issues raised in the previous Office Action are adequately addressed. One of ordinary skill in the art

armed with their knowledge and the specification would be able to practice the current invention. Accordingly, Applicant requests withdrawal of the rejections.

Regarding the rejections under 35 U.S.C. 101, Applicant respectfully contends that the claims, as now written, provide a useful, concrete and tangible result. Further, Applicant contends that one of ordinary skill in the art would be able to practice the current invention. Accordingly, Applicant requests withdrawal of the rejection.

Regarding claim 1, Applicant respectfully requests withdrawal of the rejection because neither Machin nor Sanders teach, or suggest, each and every feature in claim 23, (see also claims 29-33). Further, the invention claimed invention is not obvious in view of Machin and Sanders.

Interpreting Machin and Sanders only for the purposes of this response, Applicant submits that, to the contrary, Machin does not teach or suggest any type of method that includes, *inter alia*, “**first identifying** a plurality of operational metrics for the specific industry, wherein the operational metrics includes a factor used to measure health or viability of a **generic** company in the specific industry” (emphasis added), as in claim 1 of the present invention. To the contrary, Machin teaches and discloses, via its “gap versus solution optimizer report”, a method that employs a “summary of potential solutions available on the market for narrowing or eliminating that **gap**” (emphasis added). Col. 12, lines 17-21. Clearly, as Figure 14 shows, the suggested solutions and their various impacts (e.g., ROI, GapImpact, risk, etc.) are all in relation to how they may/may not effect the gap *in a specific company* and *not* first assessing impacts of

solution on the metrics **for the industry** and regarding a **generic company in the industry**, as in the present invention (emphasis added). In fact, Machin is completely devoid of even a suggestion of first assessing the various impacts on operational metrics for an entire industry and a generic company, as with the present invention, and then making any sort of comparison analysis. The Office agrees with the above statements regarding the lack of certain claimed elements in Machin (i.e., “assembling a set of solutions for application by the industry; assessing impacts of application of the solutions on the operational metrics for the industry”). Office Action, page 7, item 12. Further, Sanders does not remedy this glaring deficiency in Machin.

In fact, Sanders entails a system, method, and apparatus for solution for value enhancement of an enterprise. Title. The Office cites column 14, lines 10-65, for support for disclosing this aspect of the present invention. However, a careful reading of the citing section, and Sanders as a whole, indicates that Sanders is applying its invention so as to analyze and render solutions to *a single “enterprise”*, and not, at first, to an industry as in the present invention. (Emphasis added). “The solution generator then delivers recommended solutions for value enhancement *of the enterprise*, with linkages to specific functions.” Col. 7, lines 35-37. (emphasis added). Clearly, as with Machin, Sanders only applies various methodologies to a single enterprise.

Accordingly, Applicant submits that there is no teaching or suggestion in either Machin or Sanders of any type of a method that first assesses the various solutions and their impacts on operational metrics in an entire industry as viewed with regards to

operational metrics of a generic company in the industry, and then makes various comparisons and identifications regarding a specific company, as disclosed in claim 23. Therefore, Applicant respectfully requests withdrawal of the rejection of claim 23.

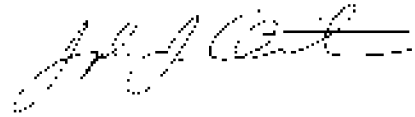
With respect to dependent claims 24-28, Applicant herein incorporates the arguments presented above with respect to the independent claim from which the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

Further, regarding independent claims 29-33 Applicant contends that for the same reasons stated above, that these claims too are allowable and, accordingly, requests withdrawal of the rejections thereto.

#### IV. CONCLUSION

In light of the above remarks, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,



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Joseph J. Christian  
Reg. No.: 51,560

Hoffman, Warnick & D'Alessandro LLC  
75 State Street, 14<sup>th</sup> Floor  
Albany, New York 12207  
(518) 449-0044